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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,972

09/08/2006

Roelof Marissen

4662-210

9943

23117

7590

03/24/2010

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EXAMINER

MERENE, JAN CHRISTOP L

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

03/24/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,972	<b>Applicant(s)</b> MARISSEN ET AL.	
	<b>Examiner</b> JAN CHRISTOPHER MERENE	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3733

### DETAILED ACTION

1. This Office action is based on the 10/586,972 application filed on September 8, 2006, which is a 371 of PCT/EP05/00936 filed January 27, 2005, which also claims Foreign Priority to EP 04075277.6 filed January 30, 2004.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 7,582,088 in view of Nesper et al US 2004/0116961. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same features and elements (i.e, surgical cable, first and second fixing plate with holes, an outer edge and

Art Unit: 3733

inner edge) and overlap in scope and subject matter. However, 7,582,088 does not disclose a groove and a ridge.

Nesper discloses a similar device with a first plate, second plate (as seen in Fig 4) with a cable (#74) and a groove and corresponding ridge (as seen in Fig 3-4), wherein the ridge is used for improved gripping (see paragraphs 47, 51).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify 7,582,088 to include the ridge and groove in view of Nesper because it helps improve gripping.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-9, 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites in line 19 "a continuous groove" and in line 21-22, recites "wherein **the a** continuous groove extends." It is unclear if the applicant is referring to the continuous groove in line 19 or a different groove. For examining purposes, the examiner will treat it as the same groove. Claim 1 lines 29-30 recites a surgical cable and how it is placed in relation to the first and second fixing plates but the language is confusing because it is unclear if these "parts" recited are part of the actual plates or spaces outside the plates.

Likewise, the applicant recited "part (j)", "part (a)", part (b)," etc but the examiner notes that the use of parenthesis is permissible but has no effect on the scope of the

Art Unit: 3733

claims, see MPEP 608.01 (m) second paragraph. It is believed that these limitations would be clearer if the parenthesis removed such that it recites "part j," "part a," "part b," etc. Likewise, as stated previously, it is unclear if the "first upward part" and "second upward part" is part of either the plates or a space outside the plates. Likewise, claim 32 recites "first upward part" and line 36 recites "the upward part" where it is unclear if the applicant is referring to the first upward part in claim 32 or a different upward part. The examiner will treat with art as best under stood.

Claim 6 recites the limitation "first and second fixing rings" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. It is unclear if the fixing rings are the same or different rings as claimed in claim 1. The examiner will treat with art as best understood.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

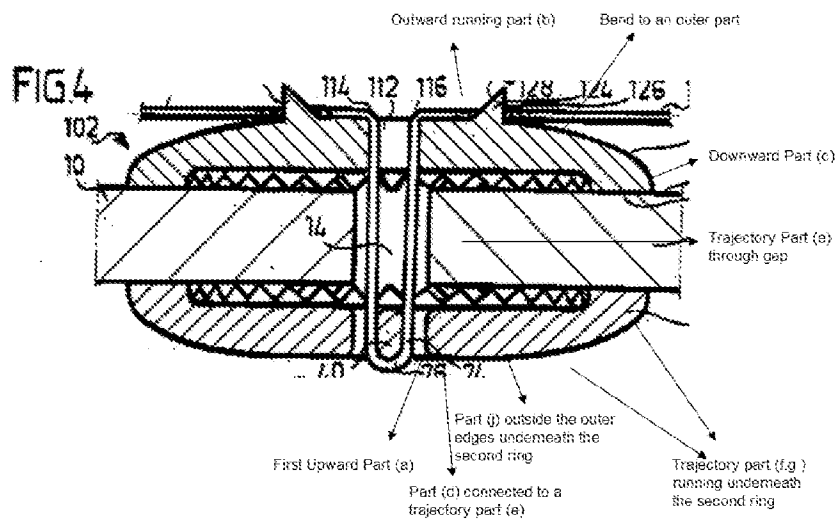
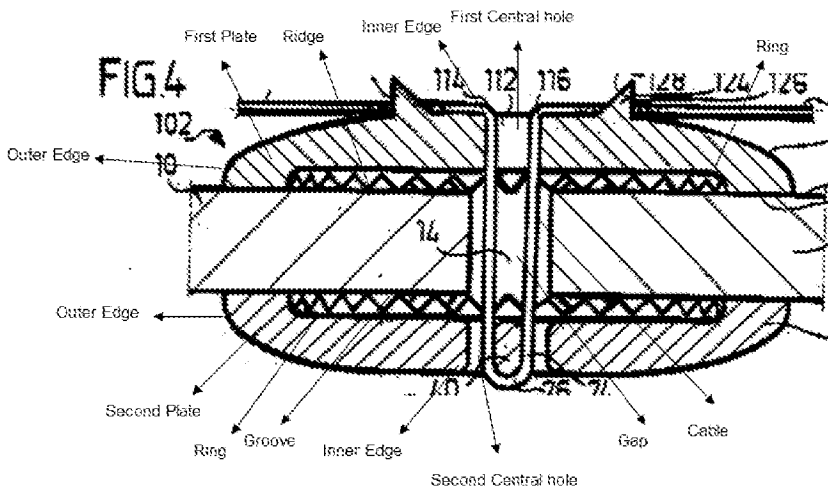
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-5, 7, 10-12** are rejected under 35 U.S.C. 102(e) as being anticipated by Nesper et al US by 2004/0116961.

Art Unit: 3733

Regarding **Claim 1**, Nesper discloses a fixing device comprising a surgical cable, First and second fixing plates, each plate having a central hole, a ring surrounding the hole, a circumference forming an outer edge, wherein the plates can be stacked on top of each other where the central holes overlap and where a gap can be formed between the plates and one of the plates has a groove and the other plate has a ridge (see fig below), wherein the cable, at least one end of the surgical cable follows continuous trajectory running as part (j) from outside the outer edges underneath the second ring up to the second hole, bending upward into a first upward part (a) running through the second and the first holes a bend to an outward part (b) running across the first ring in the direction of its outer edge downward part (c) outside said outer edge running in a direction opposite to the upward part (a), a part (d) running through the hole of the second ring part (d) at its one end being connected to a trajectory part (e) running through the gap between the first and second fixing plates and at its other end being connected to a trajectory part (f, g) running underneath the second ring and wherein the other end of the cable is connected to the first and second fixing plates (as seen in Fig below, where one can wrap the cable in the trajectory described above).



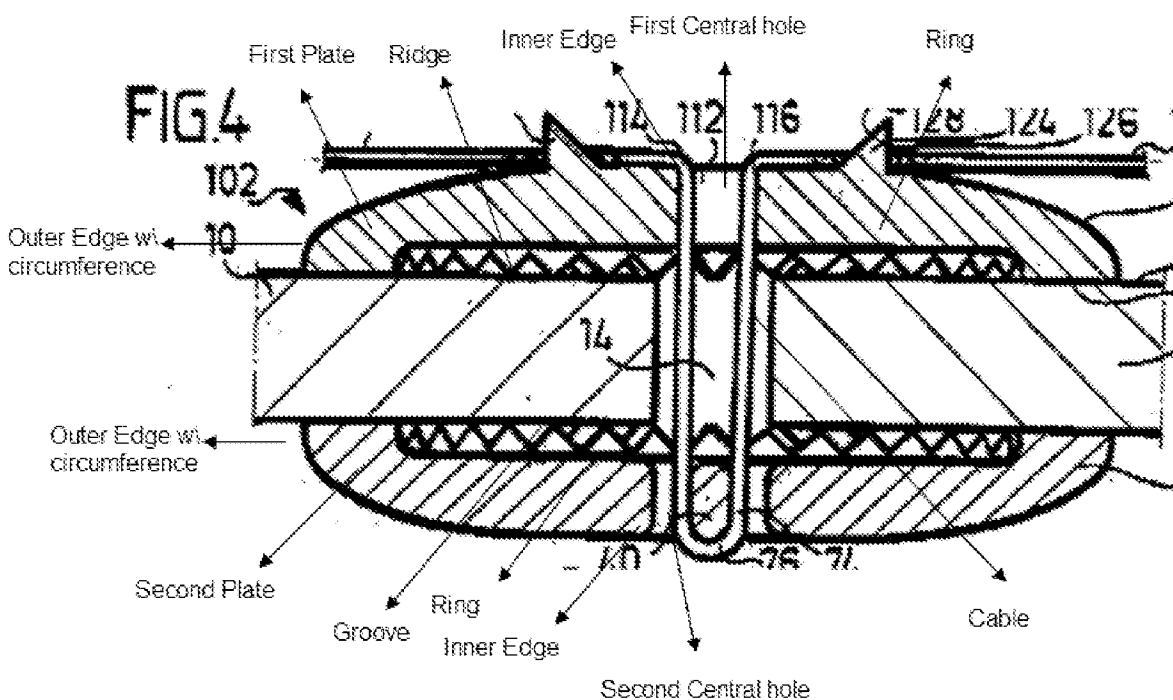
With regards to **claims 2-6**, the examiner notes that the cable of Nesper can be placed in any number of trajectories if one chooses to do so, where one can place the cable in the configurations described in claims 2-6.

Regarding **Claim 7**, Nesper discloses a method for tying bone parts together, comprising the steps of applying a fixing device according to claim 1 around the bone parts (#10, #12) to be fixed, followed by drawing the ends of the cable to tension the cable around the bone parts to the tension required to fix the bone parts (see paragraph

Art Unit: 3733

60, where the cable is tensioned, the examiner notes that the applicant is claiming the device of claim 1, wherein the device is the plates and the cable, wherein the placement of the cables as recited in claim 1 is merely functional and intended use, if the applicant wishes to claim the placement of the cables as recited in claim 1, then the applicant should include those steps in this claim).

Regarding **Claims 10-11**, Nesper discloses a set of two fixing plates each respectively having a central hole and a ring surrounding said hole, wherein each plate has a circumference forming a nouter edge, an inner edge adjacent to the hole, one of the plates has a surface with a groove, the other plate has a surface with a ridge, and a surgical cable (see Fig below).





Regarding **Claim 12**, Nesper discloses a surgical cable (#74) as seen in Fig 1) for application in a fixing device according to claim 1 (the examiner notes that the applicant is merely claiming a cable capable of being used in a device as described in claim 1).

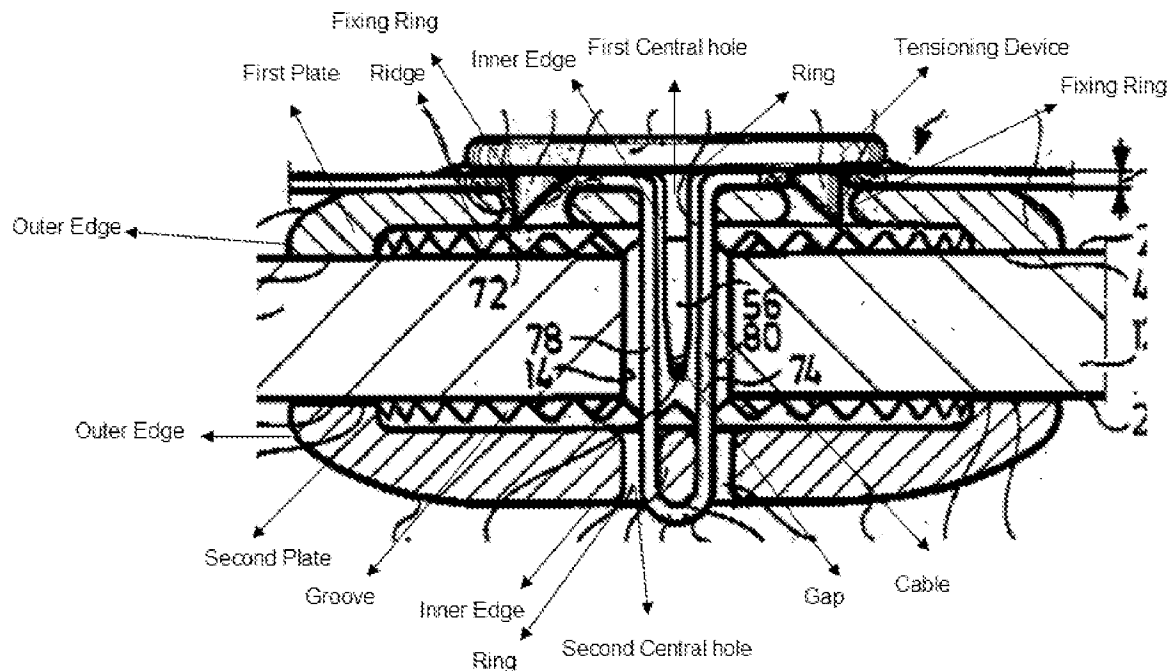
Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

8. **Claims 1, 6, 9** are rejected under 35 U.S.C. 102(e) as being anticipated by Nesper et al US by 2004/0116961.

Regarding **Claim 1**, Nesper discloses a fixing device comprising a surgical cable, First and second fixing plates, each plate having a central hole, a ring surrounding the hole, a circumference forming an outer edge, wherein the plates can be stacked on top of each other where the central holes overlap and where a gap can be formed between the plates and one of the plates has a groove and the other plate has a ridge (see fig below), wherein the cable, at least one end of the surgical cable follows continuous trajectory running as part (j) from outside the outer edges underneath the second ring up to the second hole, bending upward into a first upward part (a) running through the second and the first holes a bend to an outward part (b) running across the first ring in the direction of its outer edge downward part (c) outside said outer edge running in a direction opposite to the upward part (a), a part (d) running through the hole of the second ring part (d) at its one end being connected to a trajectory part (e) running through the gap between the first and second fixing plates and at its other end being

Art Unit: 3733

connected to a trajectory part (f, g) running underneath the second ring and wherein the other end of the cable is connected to the first and second fixing plates (as seen in Fig below, where one can wrap the cable in the trajectory described above).

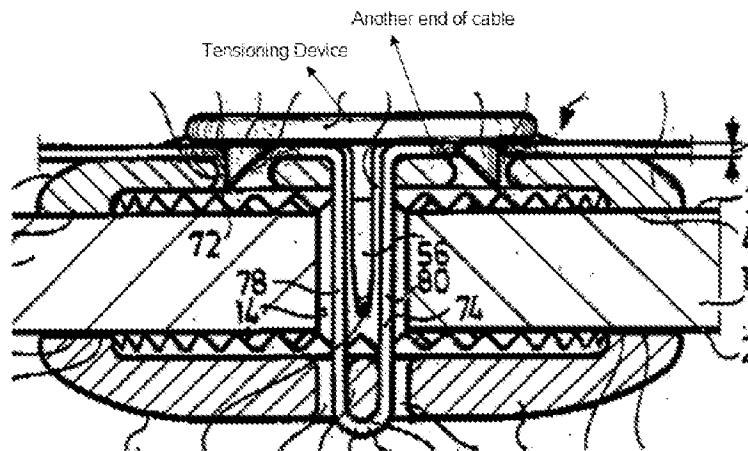


Regarding **Claim 6**, Nesper discloses a tensioning device that is connected to first and second fixing rings, wherein another end of the cable is fixed to the tensioning device (see fig above and below).

Regarding **Claim 9**, Nesper discloses a method for tying bone parts together comprising the steps of applying a bone fixing device according to claim 6 around bone parts to be fixed, followed by drawing said one end (see paragraph 59-60) of the cable to tension the cable around the bone and then tensioning the cable to the tension required to fix the bone parts by means of a tensioning device (see fig above in claims 1, 6 and paragraph 60 and the examiner notes that the applicant is claiming the device

Art Unit: 3733

of claim 6, wherein the device is the plates and the cable, wherein the placement of the cables as recited in claim 6 is merely functional and intended use, if the applicant wishes to claim the placement of the cables as recited in claim 1, then the applicant should include those steps in this claim).



### ***Response to Arguments***

9. Applicant's arguments with respect to claims above have been considered but are moot in view of the new ground(s) of rejection. The examiner notes that with applicant's amendments the rejection of the claims was changed accordingly. In response to applicant's argument that Nesper is constructed and operate in a total different matter from claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Art Unit: 3733

With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Nesper which is capable of being used as claimed if one so desires to do so. In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). The examiner notes that Nesper discloses the claimed cable, fixing plated with the holes, the inner edge, outer edge and the groove and ridge. The placement of the cable shown in Nesper is different than the claimed placement of the cable as claimed in claim 1 but one can take the cable of Nesper and arrange it to the placement/trajectory as described in claim 1.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

The examiner also notes that claim 12 is just claiming a cable that is capable of being used in the device of claim 1, not the actual plates and the trajectory of the cable. As such, ANY cable capable of being tied around two plates as described in claim 1 can meet the limitation of claim 12. Likewise claim 10-11 is just claiming two plates with the structural features disclosed in the claim and a cable and claims no function or intended use of the plates.

Likewise for claims 7, 9, the examiner notes that the applicant is claiming the use of claim 1, 6 (respectfully) where the placement of the cable is functional and the cable is capable of being placed in that configuration. The applicant is not claiming the steps of placing the cable in the trajectory path/ position in claim 1 in claims 1, 9 but that if the applicant does positively claim those steps in claims 1, 9, they would overcome Nesper.

The applicant is welcomed to contact the examiner to discuss any outstanding issues.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and relied upon is considered pertinent to the applicant's disclosure. See PTO-892 for art cited of interest.

Art Unit: 3733

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAN CHRISTOPHER MERENE whose telephone number is (571)270-5032. The examiner can normally be reached on 8 am - 6pm Mon-Thurs, alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jan Christopher Merene/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733